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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,317	08/14/2006	Bernhard Moser	3635	6836

7590  
Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

EXAMINER
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FULLER, ROBERT EDWARD

ART UNIT	PAPER NUMBER
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3676

MAIL DATE	DELIVERY MODE
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08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,317	<b>Applicant(s)</b> MOSER ET AL.	
	<b>Examiner</b> ROBERT E. FULLER	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input checked="" type="checkbox"/> Other: <u>Exhibit A</u> .                        |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because Figures 3-14 appear to be sectional views, but are not cross-hatched and are not properly referenced to another drawing, to show where the section view is taken. See 37 CFR 1.84 (h) (3) for section view guidelines and MPEP 608.02 (IX) for cross-hatching guidelines. Figure 3 is further objected to because it seems that this figure should be labeled "Prior Art." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the first free face section is cut at a right angle to the cutting edge. However, this appears to be inconsistent with the drawings. The first free face section (10a) does not appear to be "cut" at a right angle to the cutting face. The word "cut" implies that there is actual cutting going on. However, examiner understands that the claim is describing the cutting plate as it is viewed with reference to an imaginary "cutting plane" which is at a right angle to the cutting face. In that sense, it is the cutting plane, not the free face section that is cut at a right angle. Appropriate clarification and correction is required.

With further regard to claim 1, the definition of the height (H) of the rib is unclear. From the drawings, it appears that the height is measured from the intersection of the second free face section (10b) and the first free face section (10a) to the tip of the cutting edge (11). If this is true, then the height is constant and cannot vary as one changes distance from the longitudinal axis (as claimed in claims 3 and 4). Alternatively, the height could be measured from the intersection of 10a and 10b to any point on the rib. In that case, then the height is variable. What is meant by the height (H) should be more well defined in the claim. Examiner will treat claim 1 as if the height is measured from the intersection of 10a and 10b to any point on the rib. Therefore,

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with regard to claim 4, it seems that in no case does the height of the rib decrease as one moves toward the longitudinal axis. Therefore, claim 4 will be treated as if it reads that the vertical height decreases *away* from the longitudinal axis. Examiner notes that the fact that numeral 14 is only used in Figure 13 further complicates the matter.

Appropriate clarification and correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Huber (US 2006/0118341).

With regard to claim 1, Huber discloses a drilling tool (1), especially for percussion drilling, which comprises a cutting element (2) that is configured as a plate or head and that has at least one cutting edge (3) defined by a cutting face (5) and a free face (7), wherein the cutting edge is associated with a first free face section (see Exhibit A, attached) which lies in a cutting plane and is limited by a convex bulge or a convex polygon outline (see Exhibit A), and wherein the vertical height of a rib (see Exhibit A) defined by the first free face section and an associated first cutting face section appears to range from .1 mm to 1.0 mm.

With regard to claim 2, the height of the rib appears to range from .1 mm to .5 mm.

With regard to claims 3 and 4, the vertical height of the rib increases toward the longitudinal axis and decreases away from the longitudinal axis.

With regard to claim 5, a second free face section follows the first free face section (see Exhibit A).

With regard to claim 6, Huber discloses a second free face section (see Exhibit A).

With regard to claim 7, an extension (see "V" in Exhibit A) extends in a direction of rotation (see "d" in Exhibit A) of the drilling tool through the cutting element below the cutting edge.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references provide examples of cutting elements which comprise ribs.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT E. FULLER whose telephone number is (571)272-0419. The examiner can normally be reached on Monday thru Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer H Gay/  
Supervisory Patent Examiner, Art  
Unit 3676

07/28/2008  
REF